

REMARKS

This communication is a response to the final Office Action dated August 27, 2010. Claims 11-20 are pending, of which claims 11, 18, and 19 are the independent claims. By this communication, claims 11, 17, 18, and 19 are amended. Favorable reconsideration of this application in view of the foregoing Amendments and the following Remarks is respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a)

(1) Sarskog in view of Van Reenen

In numbered paragraph 4 on page 7 of the Office Action, claims 11, 18, and 19 were rejected on the basis of *Sarskog* and *Van Reenen*. The Applicants respectfully traverse this rejection.

Independent claim 11 has been reformatted in an effort to clarify the distinguishing features that have been pointed out in Applicants' previous responses. The claim recites, among other things, the steps of (1) dividing a given batch of data into a plurality of subsets, and (2) transmitting a first subset of data from the plurality of subsets of the given batch of data to a network server for backing up.

Referring to the exemplary embodiment of FIG. 1 (as described in the Applicants' previous response), mobile communication device 3 divides a given batch of data into a plurality of subsets i.e., block 1, block 2, block 3.....block 10 (blocks 1-10). At step 10, the device 3 prepares a first subset of data from the plurality of subsets of the batch of data. In the example of FIG. 1, blocks 1-3 correspond to the "first subset of data", as recited in the claims. Once the first subset of data (e.g., blocks 1-3) is prepared, the device 3 transmits the first subset of data to the server 2 for backup. Thus, in this example, during this transmission, only

the first three blocks, i.e., blocks 1-3 (the first subset of data) from the plurality of blocks, i.e., blocks 1-10 (plurality of subsets) of that specific batch of data, i.e. the given batch, is transmitted to the server 2 for backup.

Claim 11 further recites that "delaying the backup by a predetermined period of time...and resuming the backup of said given batch of data by transmitting at least one other subset of data from the plurality of subsets of the given batch of data to the network server at the end of said predetermined period of time." (emphasis added).

The Applicants respectfully submit that the grammatic construction of claim 11 clearly suggests to one of ordinary skill in the art that each subset that has been divided from a specific batch of data is individually sent for backup at different times. More specifically, the subsets from the given batch of data are sequentially transmitted for backup. Thus, with reference to the embodiment of FIG. 1, discussed above, after a predetermined period of time lapses at step 13, the backup method resumes at steps 14-16 by preparing a second subset of data (blocks 4-6) from that same batch of data, subsequent to the first subset of data. With reference to this example, the "second subset of data (blocks 4-6)" corresponds to the "at least one other subset of data from the plurality of subsets", as recited in the claims. Thus, after the first subset of data (i.e., blocks 1-3) from the plurality of subsets (i.e., blocks 1-10) has been transmitted for backup, and after a predetermined time lapses, the method proceeds at step 15 by transmitting at least one other subset (i.e., blocks 4-6) from the plurality of subsets (i.e., blocks 1-10) from the same batch of data (i.e., the given batch of data) and, at step 16, backing up the at least one other subset (i.e., blocks 4-6) at the server 2.

The above described process continues until the remainder of the subsets (blocks 7-10), from the given batch of data, subsequent to the first and second subsets (from the same batch) previously backed up, is also transmitted and backed up. Thus, the entire batch of data (blocks 1-10) is backed up over separated transmissions. In other words, a data set is divided and transmitted at different time intervals until the entire data set is backed up.

Sarskog, in contrast with claim 11, discloses that *all data* stored within a SIM card is transferred to a memory device within a transmission time interval. In other words, everything stored on the SIM card is transmitted at one time. At a later time, all of the data is again transmitted, including any changes that have been made in the meantime. *Sarskog* provides an example and discloses that a telephone book (including, e.g., telephone numbers, addresses, etc.) is saved in the SIM card and can be transferred to computer for backup. Specifically, the entire telephone book (i.e., all of its contents) is transferred at one time via one communication. See, e.g., p. 3, ll. 25-30.

In making the rejection, the Office appears to equate the telephone book with the "batch of data", as recited in claim 11, and its contents (i.e., telephone number, addresses, etc.) with "the plurality of subsets", also recited in claim 11. Even if the telephone book of *Sarskog* is considered to be made up of "subsets of data" (e.g., telephone numbers, addresses, etc.), at no point are the alleged "subsets" from the same set of data of the telephone book transmitted over separated communications. For example, the reference **does not** provide (1) transmitting a first subset from the telephone book (e.g., contacts with last names A-C) for backup, (2) waiting a predetermined amount of time, and then (3) transmitting a second subset from the same contents of the telephone book (e.g., contacts with last names D-F)

subsequent to the first subset. Rather, in *Sarskog*, all of the information (e.g., all contacts) is transmitted via one communication at a given time.

The predetermined time intervals or specific events, to which *Sarskog* refers (and upon which the Examiner relies) pertain to different times during which all of the information existing at that time transferred for backup. In other words, either after a certain time has lapsed or after a certain event has occurred, all of the information stored in the SIM card is transmitted again, via another single communication, to account for any changes. The different transmissions in *Sarskog* are not directed to different subsets from the same set of data. In *Sarskog*, all information stored in the SIM card (i.e., an entire data set) is transmitted via a single communication. The next transmission is not associated with the same set of data. Rather, it pertains to the data that exists at the later time of that transmission. In the Applicants' claim 11, the information (given batch of data) is divided into a plurality of subsets and transmitted over respective ones of a plurality of transmissions. All of those transmissions are based on a single set of data.

As recited in claim 11, each separate subset transmission (i.e., the transmission of the first subset, and the subsequent transmission of the "at least one other" subset) pertains to the overall backup of "the given batch of data". In other words, claim 11 provides that a plurality of subset transmissions occur in order to back up the given batch of data. *Sarskog*, in contrast, provides that only one transmission is required to backup all of the data stored within the SIM card. The different transmissions of *Sarskog* relate to different respective sets of data, e.g. the original contact list and an updated contact list. Regardless of the disclosed time intervals, the information within the memory of the SIM card is not divided for

individual respective data transfers, nor is it backed up in manner similar to that of claim 11.

The Office relies upon *Van Reenen* for allegedly teaching "dividing a batch of data to be backed up into a plurality of subsets...." Even if the data to be backed up in *Van Reenen* can include names, telephone numbers stored, calendar data, addresses, etc. as noted on page 8 of the Office Action, the reference is entirely silent with respect to individually sending any of the information under the aforementioned sub-headings in time-separated transmissions. For example, the reference is silent with respect to backing up information from one sub-heading (e.g., names), waiting a predetermined period of time, then backing up information from a second sub-heading (e.g., telephone numbers), and so on. Rather, like *Sarskog*, in *Van Reenen*, all the stored information is initially backed up via a single transmission. See, e.g., p. 3, ll. 15-16. In other words, all of the data from the above-noted sub-headings i.e., original data (i.e., names and telephone numbers stored in the telephone device, calendar data, addresses, files, notes, tasks, graphics, etc) are transferred for backup at the same time via the same transmission. Any later addition and/or change to the original data (i.e., if another contact is added, if a phone number changes, etc.) can be backed up individually. However, this added/changed information is not a subset from the "original" batch of data that was already backed up. Said another way, any subsequent backups of data can include either (1) only changes that have been made to the original data since the previous backup of the original data, which are not one of the original subsets of data or (2) a transfer of all the data, including the changed data.

Like *Sarskog*, data in *Van Reenen* sent in a later transmission does not pertain to the same data set, i.e. the given batch of data, that was sent in the first

transmission. Rather, it is based upon a different set of data, i.e. updated data. This is in contrast with claim 11, which recites backing up a first subset of data from the plurality of subsets of the given batch of data and then, after a predetermined period of time, backing up at least one other subset of data from the plurality of subsets of the given batch of data.

Therefore, like *Sarskog*, *Van Reenen* fails to disclose dividing a batch of data into subsets and then *separately transmitting each subset from the same batch of data*, such that each subset of the same batch of data is transmitted during different transmissions. While the Applicants submit that the claims were patentably distinct from the references as previously presented, the Applicants have, nonetheless, amended the claims to recite "a given batch of data" to clarify that each subset that is transmitted for backup is from the same batch of data (i.e., the given batch of data) in order to advance prosecution of the current application. Neither *Sarskog* nor *Van Reenen*, nor any reasonable combination thereof, teaches this claimed feature.

Accordingly, for at least the reasons set forth above, the Applicants respectfully submit that claim 11 is patentably distinct from *Sarskog* and *Van Reenen*, and request the rejection be withdrawn.

Independent claims 18 and 19, although different in scope, recite at least some of the same distinguishing features noted above with respect to claim 11. Therefore, arguments similar to those in connection with claim 11 are also applicable to claims 18 and 19. Accordingly, the Applicants respectfully submit that independent claims 18 and 19 are also patentably distinct from *Sarskog* and *Van Reenen*, and request that the rejection be withdrawn.

(2) *Dormehl* in view of *Jouenne*

In numbered paragraph 5 on page 9 of the Office Action, the Examiner maintains the rejection of claims 11-20 as allegedly being unpatentable over *Dormehl* and *Jouenne*. The Applicants respectfully traverse this rejection.

The *Dormehl* reference, in its entirety, refers to a database management system (i.e., organization of data within the server). It does not in any way pertain to the manner in which information is transmitted from a mobile communication device to a server, as recited in the claims. The reference is entirely silent with respect to first dividing a given batch of data into a plurality of subsets, sending a first subset from the plurality of subsets of the divided data, waiting a predetermined amount of time, and sending another subset from the plurality of subsets of the same batch of data. Rather, in *Dormehl*, the server receives all data from a mobile telephone, and each time it receives all the data from the mobile telephone, it compares it with data that is already backed up and organized for that telephone. It then determines either (1) to replace all of the existing data or (2) to simply update the data according to a user's instruction. At no point does *Dormehl* disclose dividing data into subsets and then separately transmitting each individual subset from the divided data (i.e., one subset at a time) to the server for back up.

Even if *Dormehl* discloses that backed up data (in the server database record) can be released to a given mobile telephone under predetermined conditions (see, e.g., p. 3, ll. 13-15), this in no way is analogous to first dividing a batch of data into a plurality of subsets and transmitting each individual subset from the divided batch of data to a server for backup after predetermined times, as recited in claim 11.

Moreover, on page 5 of the Office Action and in the Continuation Sheet of the Advisory action, the Office asserts that the predetermined conditions mentioned in

Dormehl correspond to a predetermined amount of time. The Office supports this assertion by alleging, "that the database record releases under predetermined condition, such as a PIN number or biometric identification data to the server, therefore, reference clearly teaches mobile device can be free for predetermined period of time." The Applicants respectfully disagree and submit that the reference does not support this assertion. The Applicants first note that claim 11 recites, transmitting a first subset of data from the plurality of subsets of the given batch of data to a network server for backing up, delaying backup for a predetermined period of time, and resuming backup of the given batch of data by transmitting at least one other subset of data from the plurality of subsets of the given batch of data. The predetermined conditions referenced on page 3 of *Dormehl* pertain to the situations in which the data that has already been stored in the server can be released to a user. Nowhere does *Dormehl* state that predetermined conditions include the lapsing of a predetermined amount of time, nor does the reference state that the lapse of a predetermined amount of time is associated with the process of data transmission from the phone to the database server for backup. The reference (specifically the portions relied upon by the Examiner) is entirely silent with respect to the above-noted features of claim 11.

The Applicants respectfully submit that the Office's assertions are not a legally adequate basis for maintaining the rejection. MPEP §2112(IV) emphasizes that the required showing for the Examiner to make an assertion (to establish inherency) is that the extrinsic evidence must make clear that the missing descriptive matter (i.e., delaying backup of a subsets of data by a predetermined period of time) is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

In the present case, the Examiner has not established that *delaying backup of a plurality of subsets from a batch of data by a predetermined period of time* is necessarily present in *Dormehl*. Nor does the Examiner cite a portion of the reference that discloses that the "predetermined condition", as disclosed by *Dormehl*, specifically refers to a "predetermined period of time" as recited in the claims.

Furthermore, the Examiner has not made clear that the above-noted claimed feature would be so recognized by persons of ordinary skill in the cited art. The Applicants submit that an assertion that a claim recitation is within the cited art may not be established by probabilities or possibilities. In the present case, the mere fact that the entering of a PIN number or biometric identification data (i.e., the disclosed predetermined conditions of *Dormehl*) *may* result in a delay of sending data from the server to the phone, as suggested by the Office, is not sufficient to establish the inherency of that characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)...*In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

In any event, even if the time required to enter a PIN number or biometric identification data does represent a lapse of a predetermined period of time, such period of time occurs prior to the initiation of the release of the information from the database to the Internet. There is no suggestion that the lapse of such a period of time is deliberately interposed between successive transmissions of subsets of the data, as reflected in claim 11.

In addition to the above-noted deficiencies, the Examiner acknowledges that *Dormehl* fails to disclose or suggest asynchronous backup and relies upon *Jouenne* for allegedly teaching this feature. The Office also alleges that *Jouenne* teaches that

data is resumed at the end of a predetermined period of time and relies upon col. 3, II. 64-67 for support. The Applicants respectfully disagree.

In *Jouenne*, specifically, at col. 3, II. 1-5 and at col. 3, II. 64-67 (upon which the Office relies), the deferred time only refers to the delay between when the information is updated in the issuing station and when a copy of the updated information is sent to another station. *Jouenne* provides no disclosure that the updated data is divided into subsets and that each subset from divided updated data is separately transmitted at different times. In other words, in contrast with the Office's assertions, *Jouenne* does not teach dividing a given batch of data into subsets and then separately transmitting each individual subset from the plurality of subsets of given batch of data (i.e., one subset at a time) to the server for back up with a predetermined delay between each transmission, as recited in claim 11.

For at least the foregoing reasons, the Applicants respectfully submit that neither *Dormehl* nor *Jouenne*, taken individually or in combination, discloses or suggests the claimed features and, therefore, cannot support a *prima facie* case for rejecting claim 11 under 35 U.S.C. §103(a). Thus, the Applicants respectfully request the rejection be withdrawn.

Independent claims 18 and 19, although different in scope, recite at least some of the same distinguishing features noted above with respect to claim 11. Therefore, arguments similar to those in connection with claim 11 are also applicable to claims 18 and 19. Thus, the Applicants respectfully submit that independent claims 18 and 19 are patentably distinct from the cited references and request that the rejection be withdrawn. Moreover, based at least upon their dependence from an allowable independent base claim, claims 12-17 and 20 are also patentably distinct from the cited references.

CONCLUSION

Based on the foregoing amendments and remarks, the Applicants respectfully submit that claims 11-20 are allowable and that this application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,
BUCHANAN INGERSOLL & ROONEY PC

Date: January 27, 2011

By: /Jennifer A. Wilson/
Jennifer A. Wilson
Registration No. 62604

Customer No. 21839
703 836 6620